

Application Serial No.: 09/667,502
Amendment dated February 9, 2004
Reply to Office Action dated October 8, 2003

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-19 are presently active in this case. Claims 4, 9-14, and 19 have been withdrawn from consideration.

In the outstanding Official Action, Claims 1, 5 and 6 were rejected under 35 U.S.C. 102(e) as being anticipated by Takekoshi (U.S. Patent No. 6,501,289 B1). Claims 15 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Takekoshi in view of Fumitaka. For the reasons discussed below, the Applicants traverse these art rejections.

The Takekoshi reference has a U.S. filing date of March 9, 2000. The present application claims priority under 35 U.S.C. 119 to JP 11-285139, which was filed on October 6, 1999. The certified copies of the priority document was submitted on September 22, 2000, and have been acknowledged as being received. The Applicants are submitting herewith a certified English language translation of JP 11-285139, thus perfecting the foreign priority of the present application. Accordingly, the Applicants submit that the Takekoshi et al. reference cannot be used as prior art under 35 U.S.C. 102(e) against the present application. (See MPEP 706.02(b)). Thus, the Applicants request the withdrawal of the anticipation rejection based upon the Takekoshi reference, and the obviousness rejection in which the Takekoshi reference is cited as the primary reference.

Claims 1-3, 5-8, and 15-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al. (U.S. Patent No. 5,642,056) in view of Fumitaka (JP 7-066269). For the reasons discussed below, the Applicants traverse this art rejection.

Application Serial No.: 09/667,502
Amendment dated February 9, 2004
Reply to Office Action dated October 8, 2003

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. Furthermore, the proposed modification cannot change the principle of operation of a reference.

The Applicant submits that a *prima facie* case of obviousness has not been established in the present case because (1) the references, either taken singularly or in combination, do not teach or suggest all of the claim limitations, and (2) there is no suggestion or motivation to combine the references.

The Official Action notes that the Nakajima et al. reference does not disclose measuring a load. (See page 5.) The Applicants further note that the Nakajima et al. reference does not disclose measuring a load applied to either the main chuck as recited in Claims 1, 5, and 15, or the object of inspection as recited in Claims 6 and 16. The Official Action further states that the Nakajima et al. reference describes “a load applied to the object of inspection” and “a load applied to the main chuck” at lines 1-29 of column 9. However, the Applicants note that column 9 of the Nakajima et al. reference does not disclose or even suggest a load being applied to either the object or the chuck. The Nakajima et al. reference does not discuss the application of a load, but rather the measurement of the tilting degree of the wafer-mounted table by timing the instances at which various probes contact various electrodes. (See column 9, lines 14-49, of the Nakajima et al. reference.) The Nakajima et

Application Serial No.: 09/667,502
Amendment dated February 9, 2004
Reply to Office Action dated October 8, 2003

al. reference senses this timing pattern by sensing voltage between the upper electrodes and the lower electrode. The Nakajima et al. reference does not mention or even suggest the application or measurement of a load.

The Fumitaka reference is cited for the teaching of the sensing of a load. However, the impact load discussed in the Fumitaka et al. reference is designed for a completely different purpose than the load application in the present application. It is unclear why one of skill in the art would look to such an invention, and combine it with the invention described in the Nakajima et al. reference. And, in fact, it is unclear how the impact load discussed in the Fumitaka et al. reference could be combined with the invention described in the Nakajima et al. reference in order to arrive at the present invention.

The load discussed in the Fumitaka reference is used to dislodge a semiconductor chip from a wafer sheet. The application of a load onto a needle (17) for dislodging a chip from a wafer sheet as discussed in the Fumitaka reference is unnecessary in the invention of the Nakajima et al. reference, since the Nakajima et al. does not concern itself with the dislodging of a chip from a wafer sheet. Additionally, the application of a load in the manner discussed in the Fumitaka reference would also not enhance or in any manner relate to the tilt detection and correction operation of the invention of the Nakajima et al. reference. Even if a load were measured in the Nakajima et al. reference, the Nakajima et al. reference does not teach any manner of using this information to achieve the tilt correction described therein. Thus, there is no motivation to combine the teachings of the Fumitaka reference with the Nakajima et al. reference. Accordingly, a *prima facie* case of obviousness of Claims 1, 5, 6, 15, and 16 cannot be established based upon the combination of the Nakajima et al. reference

Application Serial No.: 09/667,502
Amendment dated February 9, 2004
Reply to Office Action dated October 8, 2003

and the Fumitaka reference.

Furthermore, neither the Nakajima et al. reference nor the Fumitaka reference discuss *overdriving* a chuck and measuring the load applied, as recited in Claims 1, 5, and 6. In fact, the Fumitaka reference appears to teach away from such a feature, since the apparatus described therein is intended to provide optimal operating conditions in order to prevent possible damage to the semiconductor chip while the chip is dislodged from the wafer sheet and lifted by the collet. Accordingly, a *prima facie* case of obviousness of Claims 1, 5, and 6 cannot be established based upon the combination of the Nakajima et al. reference and the Fumitaka reference.

Furthermore, neither the Nakajima et al. reference nor the Fumitaka reference discuss the application of or measurement of load *on the main chuck*, as recited in Claims 1, 5, and 15. The Fumitaka reference describes the detection of load applied onto the needle (17) through contact with a rear of the wafer sheet (15). Accordingly, a *prima facie* case of obviousness of Claims 1, 5, and 15 cannot be established based upon the combination of the Nakajima et al. reference and the Fumitaka reference.

Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection of Claim 1, 5, 6, 15, and 16.

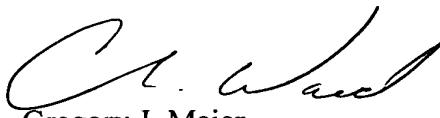
Claims 2, 3, 7, 8, 17, and 18 are considered allowable for the reasons advanced for Claims 1, 5, 15, and 16 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claims 1, 5, 15, and 16.

Application Serial No.: 09/667,502
Amendment dated February 9, 2004
Reply to Office Action dated October 8, 2003

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

GJM:CDW:brf

l:\atty\cdw\197399US2\am4.doc